

ROBERT T. HASLAM (Bar No. 071134)
 ROBERT D. FRAM (Bar No. 126750)
 GORDON W. RENNEISEN (Bar No. 129794)
 HELLER EHRMAN WHITE & MCAULIFFE
 525 University Avenue, Suite 1100
 Palo Alto, California 94301-1900
 Telephone: (415) 324-7000

JAMES R. BUSSELLE (Bar No. 75980)
 TOMLINSON ZISKO MOROSOLI & MASER
 200 Page Mill Road, Second Floor
 Palo Alto, California 94306
 Telephone: (415) 325-8666

Attorneys for Plaintiff, Counterclaim-
 Defendant, and Counterclaimant
 RSA Data Security, Inc.

FILED

SEP 24 4 01 PM '96

RICHARD W. WIEKING
 CLERK
 U.S. DISTRICT COURT
 NO. DIST. OF CA, S.J.

199

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

C-94-20512-SW

RSA DATA SECURITY, INC., a
 Delaware corporation,

Plaintiff,

v.

CYLINK CORPORATION, a
 California corporation, CARO-
 KANN CORPORATION, a California
 corporation, and THE BOARD OF
 TRUSTEES OF THE LELAND
 STANFORD JUNIOR UNIVERSITY, a
 California corporation,

Defendants.

Case No. C96-20094-SW (PVT)

PLAINTIFF'S MEMORANDUM OF
 POINTS AND AUTHORITIES IN
 OPPOSITION TO DEFENDANTS'
 MOTION IN LIMINE TO EXCLUDE
 TESTIMONY OF TECHNICAL EXPERTS

The Hon. Spencer Williams

AND RELATED COUNTERCLAIMS.

I. INTRODUCTION

There is no basis for Defendants' motion to preclude technical experts from testifying at the Markman hearing.^{1/} The motion is meretricious and premature and should be denied.

As the Court anticipated when it set a discovery track for Markman expert depositions, plaintiff RSA Data Security, Inc. ("RSA") has designated technical experts to testify at the claim construction hearing. Defendants chose not to designate any experts, however, and now seek to exclude or limit the testimony of RSA's experts.

Defendants' entire motion rests on the erroneous assumption that expert testimony is suspect evidence to be admitted and considered only in rare circumstances. The law is contrary to Defendants' assumption. Markman itself, as well as numerous subsequent decisions by the Federal Circuit, confirm that a district court considering the meaning of disputed patent terms may admit and rely on expert testimony.

To the extent that Defendants' motion seeks to have the Court draw a distinction between expert testimony concerning the meaning of patent terms and expert testimony concerning ultimate legal issues of claim construction, the motion is premature. It is pointless for Defendants to attempt to excise certain opinions from the anticipated testimony of RSA's experts before those experts even take the stand at the Markham hearing. The Court,

^{1/} Defendants Cylink Corporation, Caro-Kann Corporation and Stanford University (collectively "Defendants" or "Cylink") filed the Expedited Motion in Limine to Exclude Technical Expert Testimony ("Defendants' Expert Motion").

1 not Defendants, must determine which expert testimony is helpful
2 and which expert testimony is not. At the Markman hearing the
3 Court will have an opportunity to evaluate the testimony of RSA's
4 experts and Defendants will have an opportunity to object to any
5 particular questions which they deem to call for impermissible
6 legal opinion.

7 II. ARGUMENT

8 A. The Testimony Of Technical Experts Is Admissible.

9 It is well settled that extrinsic evidence, including
10 expert testimony, is admissible "'to aid the court in coming to a
11 correct conclusion' as to the 'true meaning of the language
12 employed' in [a] patent." Markman v. Westview Instruments, Inc.,
13 52 F.3d 967, 980 (Fed. Cir. 1995), aff'd 517 U.S. ___, 134
14 L.Ed.2d 577, 116 S.Ct. 562 (1996) (quoting Seymour v. Osborne, 78
15 U.S. (11 Wall) 516, 546 (1871)). Indeed, Defendants concede that
16 "testimony from technical experts concerning the factual matter
17 of how terms are used in the art" is admissible. Defendants'
18 Expert Motion at 3:20-23. Despite this concession, Defendants
19 attempt to argue that expert testimony is disfavored evidence
20 which courts should be reluctant to admit or consider. Id. at
21 3:26 - 4:13. (citing Vitronics Corporation v. Conceptronic,
22 Inc., 90 F.3d 1576 (Fed. Cir. 1996)). Defendants' argument must
23 fail.

24 First, Vitronics is only a panel decision, it cannot
25 overrule the numerous other recent decisions of the Federal
26 Circuit concerning extrinsic evidence. In the wake of Markman
27 the Federal Circuit repeatedly has confirmed that expert
28

1 testimony is important evidence which properly may be admitted
 2 and considered by courts construing patent claims. See e.g.
 3 National Presto Industries, Inc. v. West Bend Company, 76 F.3d
 4 1185, 1190 (Fed. Cir. 1996) (district court properly admitted
 5 expert testimony regarding the meaning of various disputed claim
 6 terms used in a patent for a vegetable cutter); Pall Corporation
 7 v. Micron Separations, 66 F.3d 1211 (Fed. Cir. 1995) (testimony
 8 of technical expert properly admitted). Indeed, the Federal
 9 Circuit itself has been "greatly aided in understanding. . . terms
 10 in the context in which they are used by consideration of the
 11 testimony of. . . expert witnesses." National Presto, 76 F.3d at
 12 1190. See also Hoechst Celanese Corporation v. BP Chemical
 13 Limited, 78 F.3d 1575, 1579 (Fed.Cir. 1996) (Federal Circuit
 14 relies on "the testimony of experts in the field" regarding "the
 15 scientific meanings of stable and dimension as applied to
 16 macroreticulated cation-exchange resins in organic medium.")

17 Second, Vitronics itself does not sweep as broadly as
 18 Defendants contend. Contrary to Defendants' assertions,
 19 Vitronics does not direct courts to exclude expert testimony.
 20 Rather, the case expressly notes that a trial court is entitled
 21 to hear all extrinsic evidence, including expert testimony,
 22 before construing the claims at issue. *Id.* at 1584 - 85 (holding
 23 that the trial court did not err in admitting expert testimony,
 24 but erred in using extrinsic evidence to contradict the manifest
 25 meaning of the claims).^{2/}

26
 27 ^{2/} Defendants are also wrong in suggesting that Vitronics stand
 28 for the proposition that "inventor testimony" carries more
 (continued...)

1 In light of the Federal Circuit's numerous post-Markman
 2 decisions holding that the testimony of technical experts is
 3 admissible in construing the terms of a patent, Defendants cannot
 4 credibly argue that such testimony should be presented in a
 5 tutorial format and treated as "factual background" rather than
 6 as "admissible objective evidence." Defendants' Expert Motion at
 7 4:26-5:2. Expert testimony is admissible evidence and should be
 8 part of the record.

9 As the court noted in Markman: "When, after
 10 considering the extrinsic evidence, the court finally arrives at
 11 an understanding of the language as used in the patent and
 12 prosecution history, the court must then pronounce as a matter of
 13 law the meaning of that language." Markman, 52 F.3d at 981. In
 14 setting down its findings regarding the meaning of patent
 15 language, this Court will need to be able to cite to the evidence
 16 supporting its conclusions. See National Presto, 76 F.3d at 1190
 17 (district court properly relied on expert witness testimony
 18 admitted as evidence in determining meaning of patent terms).
 19 Limiting expert testimony to the tutorial would leave the record
 20 incomplete and would essentially preclude this Court from
 21 referring to any expert testimony in support of its rulings.

22
 23
 24

2/(...continued)

25 "evidentiary weight" than expert testimony. Defendants'
 26 Expert Motion at 4:8-12. Vitronics actually holds that "the
 27 inventor's subjective intent as to claims scope, when
 28 unexpressed in the patent documents" cannot have any effect.
Vitronics, 90 F.3d at 1584. In order for an inventor's
 testimony to carry any weight, the inventor must be
 testifying as "an expert in the field." Hoechst Celanese
Corporation v. B.P. Chemicals Limited, 78 F.3d at 1580.

1 B. Defendants' Motion Is Unworkable And Premature.

2 Ultimately, Defendants' motion must fail because the
3 relief requested makes no sense. Notwithstanding their attempt
4 to confine all expert testimony to the tutorial, Defendants
5 acknowledge that RSA will be entitled to present expert testimony
6 in the context of the Markman hearing. Defendants then ask the
7 Court to "scrutinize" this testimony, exclude any testimony going
8 to the ultimate legal issue of the proper construction of the
9 claims, and carefully consider the weight to be given to
10 testimony concerning the interpretation of particular terms. See
11 Defendants' Expert Motion at 5:2-18.

12 Until RSA's experts take the stand, there is no
13 testimony for the Court to scrutinize or weigh. Similarly, until
14 RSA's witnesses have begun testifying it is inefficient, if not
15 impossible, to attempt to draw a line distinguishing "term
16 interpretation" testimony from "claim construction" testimony.

17 Debating the proper scope of expert testimony at this
18 time will result in an unnecessary side show. RSA anticipates
19 that its experts will testify for no more than a few hours each
20 at the Markman hearing. At the hearing, Defendants will have an
21 opportunity to object to any questions which they perceive as
22 calling for improper or inadmissible answers. The Court will
23 then be able to evaluate specific objections in context. The
24 Court will also be able to consider all expert testimony and give
25 to each portion of that testimony the weight which the Court
26 deems appropriate.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
III. CONCLUSION

For the foregoing reasons, this Court should deny Defendants' motion to exclude or limit the testimony of RSA's experts at the Markman hearing. Under Markman and its progeny, testimony of technical experts is admissible extrinsic evidence. To the extent that Defendants are concerned that RSA's experts may seek to give opinions on matters not properly within the scope of expert testimony, the Court can most efficiently address such concerns by considering timely objections at the Markman hearing.

Dated: 9/24, 1996

HELLER EHRMAN WHITE & MCAULIFFE

By: 

GORDON W. RENNEISEN
Attorneys for Plaintiff,
Counter-Claim Defendant, and
Counterclaimant
RSA DATA SECURITY, INC.